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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/032,700	12/28/2001	Paul T. Van Gompel	659-911	5367
757	7590	04/07/2006	EXAMINER	
BRINKS HOFER GILSON & LIONE P.O. BOX 10395 CHICAGO, IL 60610			STEPHENS, JACQUELINE F	
			ART UNIT	PAPER NUMBER
			3761	

DATE MAILED: 04/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/032,700	VAN GOMPEL ET AL.
	Examiner Jacqueline F. Stephens	Art Unit 3761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 08 March 2006.  
 2a) This action is FINAL.                            2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-10 and 12-44 is/are pending in the application.  
 4a) Of the above claim(s) 38-40 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-6,9,10,12-24, 27-37, 41-44 is/are rejected.  
 7) Claim(s) 7,8,25, 26, 43, and 44 is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Arguments***

1. Applicant's arguments filed 10/26/05 have been fully considered but they are not persuasive. Applicant argues Sauer does not disclose a fastener attached to a body side of a second body panel. However, Figures 2 and 3 clearly show the fastener attached to a body side of a first panel, and particularly with the extension of the fastener, the fastener can be attached to a body side of the front panel which comprises a nonwoven material and is suitable for attaching a hook-type fastener. Whether or not the item is intended to be used in this manner, it still is capable of being used in this manner. Intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). If the prior art structure is capable of performing the intended use, then it meets the claim limitations.

***Claim Rejections – 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-6, 9, 10, 12-15, 41, and 42 are rejected under 35 U.S.C. 102(b) as being anticipated by Sauer USPN 5624428.

With regard to claims 1, 2, 5, 14, and 15, Sauer discloses a refastenable absorbent garment comprising: a first body panel 24 having a body side and a garment side; a second body panel 22 having a body side and a garment side; and a fastener member 36,38 attached to the body side of the first body panel and comprising a refastenable portion 44 formed on a garment side of the fastener member. Sauer teaches the refastenable portion 42 is releasably attached to the body side of the second body panel (col. 7, lines 27-30), wherein the refastenable portion is capable of directly engaging the second body panel. The limitation of "said refastenable portion directly engages said second body panel" is directed to an intended use of the article. Intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art.

See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). If the prior art structure is capable of performing the intended use, then it meets the claim limitations.

As to claims 3 and 4, see col. 7, lines 46-50.

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As to claim 6, the fastener member comprises a first portion 42 attached to the body side of the first body panel and a second portion 44 releasably attached to the body side of the second body panel, wherein the first and second portions are hingedly connected (by hinge 46 -Figures 1-3 and col. 8, lines 55).

As to claim 9, the first portion 42 is bonded to the second portion 44 via the member 46 (Figure 3).

As to claim 10, regarding the limitations of a folded configuration, contact of the body panels, and contact of the first and second portion of the fasteners these limitations are directed to an intended use of the article. Intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). If the prior art structure is capable of performing the intended use, then it meets the claim limitations. The invention of Sauer meets the structural limitations of claims 1 and 6 and is capable of being folded in the claimed configuration.

As to claim 12, see Figure 3.

As to claim 13, see col. 7, lines 46-50.

As to claims 41 and 42, the limitations of the fastener member not directly or indirectly engaging with the garment side of the first and second body panels is directed to a function of the fastener member. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997); see also *In re Swinehart*, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). “Apparatus claims cover what a device is, not what a device does.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 16-24, and 27-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sauer USPN 5624428.

As to claims 16, 17, 20, 21, 22, 24, 28, 29, 30, 34, 35, and 37 Sauer discloses a refastenable absorbent garment and inherently a method for providing such garment comprising: providing a first body panel 24 having a body side and a garment side, and an outboard side edge; a second body panel 22 having a body side and a garment side and an outboard side edge; a fastener member 36,38 comprising first and second portions, 42 and 44 respectively, each having an inboard and an outboard edge, wherein the first portion 42 is attached to the body side of the second body panel (col. 9, lines 54-56). Sauer does not explicitly teach the second portion is releasably attached to the body side of the second body panel. However, Sauer teaches her primary fastener is releasably engageable with the bodyside liner (col. 7, lines 27-30). Therefore, it would be obvious to one having ordinary skill in the art at the time of the invention to modify the second portion 44 so that it directly engages the second body panel since Sauer teaches her secondary fasteners 44 are intended to maintain the front and rear portions of the article connected and Sauer shows the primary and secondary fasteners connected in the same manner (in Figures 2 and 3 the fasteners 42 and 44 are both connected to the outer cover, so the examiner

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has reasonable basis to conclude if the fastener 42 were connected to the bodyside liner, the fastener 44 would be also). The first and second portions are hingedly connected (by hinge 46 -Figures 1-3 and col. 8, lines 55).

As to claims 18, 23, 31, and 32, see col. 7, lines 46-50.

As to claims 19 and 33, see col. 7, lines 13-29.

As to claim 27, the first portion 42 is bonded to the second portion 44 via the member 46 (Figure 3).

As to claim 36, Sauer discloses the present invention substantially as claimed, except Sauer does not specifically disclose an adhesive fastener. It would have been an obvious matter of design choice to use an adhesive fastener as compared to a mechanical fastener, since applicant has not disclosed that the adhesive fastener solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with an adhesive or mechanical fastener.

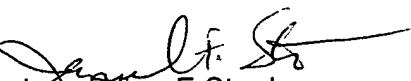
#### ***Allowable Subject Matter***

7. Claims 7, 8, 25, 26, 43 and 44 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacqueline F. Stephens whose telephone number is (571) 272-4937. The examiner can normally be reached on Monday-Friday 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tanya Zalukaeva can be reached on (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jacqueline F Stephens  
Primary Examiner  
Art Unit 3761

March 24, 2006